

REMARKS/ARGUMENTS

I. General Remarks.

Applicants respectfully request that the Examiner reconsider the application in view of the following remarks.

II. Disposition of the Claims.

At the time of the Office Action, Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were pending in the application. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were rejected. In order to advance the prosecution of this Application, Applicants herein cancel Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24, 33-37, 39, and 40 without prejudice or disclaimer.

III. Remarks Regarding Rejections Under 35 U.S.C. § 102.

A. Claims 25-29, 31, and 32 are not Anticipated by *Doyel III*.

Claims 25-29, 31, and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,130,195 issued to Doyel et al. ("*Doyel III*").^{1,2} Applicants respectfully traverse these rejections for the reasons discussed below.

In order to establish a *prima facie* case of anticipation, all the elements of the claimed invention must be found within a single prior art reference. *Dewey & Almy Chemical Co. v. Mimex*, 124 F.2d 986, 52 USPQ 138 (2d Cir. 1942). Applicants respectfully submit that each and every element of Claims 25-29, 31, and 32 is not found within *Doyel III*.

Claim 25 recites:

A method of removing a furan-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

¹ In the Office Action, the Examiner refers to U.S. Patent No. 6,130,195 as being issued to "Bixenman." However, Bixenman is actually the second-named inventor. The first-named inventor is Doyel.

² In the Office Action mailed July 1, 2005, the Examiner cited U.S. Patent No. 5,962,383 issued to Doyel et al. Applicants referred to the '383 patent as "*Doyel*". In the Office Action mailed May 15, 2006, the Examiner cited U.S. Patent No. 6,060,439 issued to Doyel et al. Applicants referred to the '439 patent as "*Doyel II*." Continuing this trend, Applicants shall refer to U.S. Patent No. 6,130,195 issued to Doyel et al. as "*Doyel III*."

Applicants submit that *Doyel III* fails to teach, suggest, or disclose all of these elements. For example, *Doyel III* fails to teach, suggest, or disclose “applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin.” In fact, *Doyel III* is entirely silent regarding furan-based resins. This is reflected by the fact that the Examiner fails to cite a single portion of *Doyel III* disclosing this element and instead focuses on cleaning surfaces coated by epoxy-based resins, not furan-based resins. See Office Action, p. 3. For at least this reason, the rejection of Claim 25 is improper. Therefore, Applicants respectfully request that the rejection of Claim 25 be withdrawn.

Claims 26-29, 31, and 32 depend from Claim 25. Therefore, Applicants respectfully submit that Claims 26-29, 31, and 32 are allowable over the cited art, for example, for reasons similar to those discussed above with regard to Claim 25. Applicants respectfully request that the rejections of Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-32 be withdrawn.

B. Claims 25-32 are not Anticipated by *Kondoh*.

Claims 25-29, 31, and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,954,891 issued to Kondoh et al (“*Kondoh*”).³ Applicants respectfully traverse these rejections for the reasons discussed below.

As discussed above, in order to establish a *prima facie* case of anticipation, a single prior art reference must disclose each and every element of the claimed invention. *Dewey & Almy Chemical Co. v. Mimex*, 124 F.2d 986, 52 USPQ 138 (2d Cir. 1942). *Kondoh* fails to do this for Claims 25-29, 31, and 32.

Consider Claim 25. Claim 25 recites:

A method of removing a furan-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

³ In the Office Action, the Examiner refers to U.S. Patent No. 5,954,891 as being issued to “Kashihara.” However, Kashihara is actually the second-named inventor. The first-named inventor is Kondoh.

Kondoh fails to teach, suggest, or disclose all of these elements. For example, *Kondoh* fails to teach, suggest, or disclose “applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin.” Instead, *Kondoh* discloses a “method for removing resinous stains . . . which are adhered to surfaces of hard materials and difficult to be removed.” Col. 14, ll. 31-34. These include resins, such as plastic lens resins, adhesives, tackifiers, adhesives for temporary fixing, fixing agents, bonding agents, sealing agents, binders, paints, and protective films. Col. 14, ll. 34-67. However, *Kondoh* fails to teach, suggest, or disclose using the method for removing furan-based resins. In fact, *Kondoh* is entirely silent on the subject of furan-based resins. For at least this reason, the rejection of Claim 25 is improper. Therefore, Applicants respectfully request that the rejection of Claim 25 be withdrawn.

Claims 26-29, 31, and 32 depend from Claim 25. Therefore, Applicants respectfully submit that Claims 26-29, 31, and 32 are allowable over the cited art, for example, for reasons similar to those discussed above with regard to Claim 25. As such, Applicants respectfully request that the rejections of Claims 26-29, 31, and 32 be withdrawn.

IV. No Waiver.

All of Applicants’ arguments are made without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in an Appeal, if appropriate. Moreover, Applicants’ silence in the face of any additional statements made by the Examiner should not be interpreted as acquiescence. Instead, Applicants believe the example distinctions discussed herein are sufficient to overcome the Examiner’s rejections.

SUMMARY

In light of the above remarks and amendments, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe no fee is due in association with the filing of this Amendment and Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees also be charged to Deposit Account No. 08-0300.

Respectfully submitted,



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